



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,679	09/20/2000	Yuegang Zhang	DP-664 US	9832

7590 09/24/2002

McGinn & Gibb PC
1701 Clarendon Boulevard Suite 100
Arlington, VA 22209

EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
1754	8

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	665679	Applicant(s)	Zhang
Examiner	W. J. L. S.	Group Art Unit	1789

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

Responsive to communication(s) filed on 7/12/02

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 13-31 is/are pending in the application.

Of the above claim(s) 33 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 13-32, 34 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement

Application Papers

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

All Some* None of the:

Certified copies of the priority documents have been received.

Certified copies of the priority documents have been received in Application No. _____.

Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Art Unit: 1754

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Claim 33 is drawn to a nonelected invention and is withdrawn from consideration.

Claims 13-32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A) In claims 13, 26 and 32, 'associated with' is unclear. Is a mixture meant? Claim 20 is similarly unclear as to how the product claim is being limited. 'combined' is unclear in claim 16, as to whether a mere mixture is meant.
- B) In claim 24, 'low' is subjective and thus unclear, and further unclear how it limits the product claimed. Similarly, in claim 25 'short' is unclear.
- C) Claim 31 is unclear. 5%?
- D) In claim 34, 'substantially curved' is subjective and unclear. Is it curved or not? Perhaps a radius of curvature is intended.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-31 and 34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- A) In claim 26, 'powder' is new matter not supported in the specification.

B) In claim 34, 'non-graphite' is new matter, especially in that negative limitations must have explicit support.

Claims 14, 21, 22, 24 and 25 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are redundant, as all fullerenes inherently have 5 and 6 membered rings.

Claims 13-25, 32 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thess et al. article.

Thess teaches on the fourth page 5-member carbon rings, such as metallated C60, also taught are nanotubes. The material appears to be the same or can be chosen to be the same by altering the metal content of the formula, and/or as varying lengths of fibers are grown.

Claims 13-17, 19-25, 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Pradeep et al. article.

Pradeep teaches Ni-C60 and Ni(C60)2. Ni is a catalyst. The intended use, target, does not limit the product claimed.

Applicant's arguments with respect to claims 13-32 and 34 have been considered but are moot in view of the new ground(s) of rejection.

Concerning Thess, the reference teaches the claimed metals. Arguments to process steps are irrelevant.

Art Unit: 1754

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



Stuart Hendrickson
examiner Art Unit 1754